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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,480	07/21/2003	Jean-Christophe Simon	032487-005	4520

7590

06/28/2006

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

P.O. Box 1404

Alexandria, VA 22313-1404

EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 06/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/622,480	<b>Applicant(s)</b> SIMON ET AL.	
	<b>Examiner</b> Gina C. Yu	<b>Art Unit</b> 1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 12-14 and 49-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5-11 and 15-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/17/05, 4/7/06</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

Claims 49-55 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claims 2-4 and 12-14 are further withdrawn from further consideration as being drawn to a nonelected species.

Applicant timely traversed the restriction/election requirement in the reply filed on April 7, 2006. Applicant's election with traverse of the invention of claims 1-48 in the reply filed on April 7, 2006 is acknowledged. The traversal is on the ground(s) that independent claims 1, 49, 53, and 55 have the goniochromatic coloring agent in common. Applicants assert that these inventions are closely related and "a proper search of any of the claims should, by necessity, require a proper search of the others". This is not found persuasive for the reasons explained in the election required mailed on February 7, 2006. A search for a composition does not necessarily include the method of using thereof or a kit comprising the composition with other component, such as a transparent gloss composition.

Applicants' election with traverse of the species "particles of a synthetic substrate at least partially coated with at least one layer of at least one metallic compound" in the same reply is also acknowledged. The traversal is on the ground that there is no showing of serious burden in examining all the recited species. In response, examiner respectfully points out the fact that "the light reflective particles" as disclosed in the claims and specification include a wide variety of substrates and coating materials, which have different sources and different effects. See, e.g., [0060]-[0095].

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 5-11, 15-48 are examined on the merits.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1, 5-11, 26-28, 30-41, 43-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Simon (FR 2777178) as further evidenced by applicants' own disclosure.**

Simon discloses cosmetic composition comprising goniochromatic coloring agents and monochromic pigments such as titanium dioxide, which meets the limitation of the light reflective pigments. See English equivalent, US 6451294 B1, col. 5, lines 41 – 65. See instant claims 1, 13, 14, 40, 41. The liquid crystal colorants and multilayer structured colorants, such as Al/SiO<sub>2</sub>/Al/SiO<sub>2</sub>/Al and Fe<sub>2</sub>O<sub>3</sub>/SiO<sub>3</sub>/Al/SiO<sub>2</sub>/Fe<sub>2</sub>O<sub>3</sub>, are taught. See col. 3, line 49 – col. 5, line 13. See instant claims 30-32. Mica covered with titanium oxide meets limitation “particles of a substrate at least partially coated with at least one layer of at least one metal”. See col. 4, line 4: instant claims 5-11. The reference also teaches the amount of which goniochromatic or monochromic pigment is used. See col. 5, lines 34-40. See instant claims 26-28, 33, 34, 35.

Simon also teaches making lip gloss paste, lipstick, nail varnish, foundation, and mascara by applying the teaching of the reference. See col. 8, lines 49 – 67; instant claims 44 – 48.

The prior art meets every limitation of instant claim 1. Since the composition and its properties are inseparable, the prior art composition having at least one goniochromatic compound and at least one light reflecting pigment as defined in claim 1 inherently has the “mean gloss” properties as defined in the instant claims 15–17.

The reference teaches using the hydrocarbon oils, paraffins, Parleam, silicone oils, etc. See col. 6, line 55 – col. 7, line 37. The limitation of instant claims 36-39 are met since applicants’ disclosure provides that these oils are useful to be liquid gloss and reflective index of between 1.47-1.51. See specification, p. [00113]-[00121].

**Claims 1, 5-11, 15-20, 26-28, 33-35, 40-42, 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Blin et al. (FR 2816830).**

Blin et al. teach nail varnish compositions having a first base composition with coloring agent, and a second topcoat composition comprising 10 % by weight of interferential flat fibers in lipophilic medium. See English equivalents, US 2004/0076649 A1, [0017]. See instant claim 33-35, 42, 43, and 46. The reference also teaches adding to the top composition preferably 0.02-20 % by weight of additional pigments selected from pearlescent agents, such as mica coated with titanium oxide or iron oxide. See [00127]. See instant claims 1, 5-11, 15-20, 40, 41. The flat fibers have length of 1-10 microns. See [0027]; See instant claim 26-28.

**Claims 1, 5-11, 15-29, 33-35, 40, 41, 43-48 are rejected under 35**

**U.S.C. 102(a) and (e) as being anticipated by Pfaff et al. (US 6267810 B1) as further evidenced by applicants' own disclosure.**

Pfaff teaches using a mixture of pigments of  $\text{Al}_2\text{O}_3$  flakes coated with one or more metals, metal oxides and/or metal sulfides and special-effect pigments in varnishes and cosmetic formulations. See abstract; instant claims 44-48. See Example 4, an anhydrous composition comprising petrolatum, 15 % by weight of  $\text{TiO}$  coated  $\text{Al}_2\text{O}_3$  flakes and 15 % by weight of  $\text{TiO}_2$ -coated mica. See instant claims 33, 34, 36-39, 43. The limitation of instant claims 36-39 are met since applicants' disclosure provides that petrolatum has the mean gloss and reflective index that are useful for the present invention. See specification, p. [00113]-[00121].

See also Example 1 of Pfaff, a paint composition comprising 2.50 % of  $\text{Fe}_2\text{O}_3$ -coated  $\text{Al}_2\text{O}_3$  flakes having a particle size of 5-60 microns, special-effect pigments, and pigment-grade carbon black (a non-goniochromatic coloring agent). See instant claims 35, 40, 41. As for the special-effect pigments, the reference teaches using aluminum and gold bronze alloys having particle size of 2-40 microns. See col. 2, lines 33 – 63. See instant claims 21-25. The special-effect pigments also include coated platelet-shaped iron oxide, aluminum flakes of coated aluminum flakes,  $\text{TiO}_2$  flakes or  $\text{SiO}_2$  flakes coated with one or more metal oxides. See col. 2, lines 40 – 52; instant claims 5-11 and 29. The reference also teaches  $\text{Al}_2\text{O}_3$  flakes are coated with chromium, nickel, silver, copper, or molybdenum alloy. See col. 2, lines 14 – 29; instant claims 5-7. It is viewed that, since the applicants are claiming the same coated  $\text{Al}_2\text{O}_3$  that are taught by the prior art, the reflective particles of the prior art inherently possesses the properties as recited in instant claim 20. Since the composition and its properties are inseparable, the prior

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art composition having at least one goniochromatic compound and at least one light reflecting pigment as defined in claim 1 inherently has the “mean gloss” properties as defined in the instant claims 15 – 17.

As for claims 44, 45, 47, 48, the terms “gloss”, “lip makeup”, “foundation”, and “mascara” are preambles which define the intended future use or purpose of the composition rather than how the structural makeup of the composition of claim 1. See MPEP § 2111.02. Thus, these terms are not afforded any patentable weight.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

**Claims 1, 5-11, 30-35, 42, 44-48 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 66-73, 111-124, 143, 144 of copending Application No. 10/432329.**

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Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions comprising interference pigment and one additional pigments such as pearlescent such as mica coated with metal oxides. See '329, claim 121; instant claims 5-11. The interference pigments of the '329 application are polymeric fibers, which are also claimed in the instant application, claim 42. The interferential particles of the copending applications, claims 112 is also claimed in instant claim 31 and 32. See also overlapping weight amount of the pigments in '329, claims 113-115 and instant claims 33-35.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

No claims are allowed.

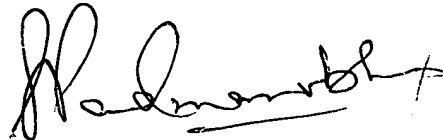
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 571-272-8605. The examiner can normally be reached on Monday through Friday, from 9:00AM until 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Gina Yu  
Examiner

A handwritten signature in black ink, appearing to read 'S. Padmanabhan', with a horizontal line underneath.

**SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER**